



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/042,678 | 01/11/2002 | Harold L. Schafer | Techpro # 1-2 | 7412 |

7590 08/25/2004

ARTHUR R. EGLINGTON, ESQ.
113 Cross Creek Drive RD # 5
Pottsville, PA 17901

EXAMINER

COOLEY, CHARLES E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1723

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/042,678

Applicant(s)

SCHAFFER ET AL.

Examiner

Charles E. Cooley

Art Unit

1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached sheet. — "Advisory Action"

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7.

Claim(s) withdrawn from consideration: 8.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.



Charles E. Cooley
Primary Examiner
Art Unit: 1723

ADVISORY ACTION

1. The response filed 11 AUG 2004 is deficient in many respects and cannot be entered for the following reasons:

Drawings

2. The drawings remain objected to under 37 CFR § 1.83(a) since the drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the features canceled from the claims. No new matter should be entered.

a. the subject matter of claim 2 - note the now claimed lip seals do not appear to possess a squared cross section as seen in Fig. 9. Also note the new matter rejection below on this issue. Applicant's remarks on this issue are not compelling for the reasons set forth below.

b. the subject matter of claim 1, section (e) - previously recited in claim 5. Note the specification at page 10, last full paragraph states that this feature is "not seen". The abutting planar surfaces of the pneumatic housings of adjacent rotors is not shown. Accordingly, this feature must be shown to maintain the allowable status of claim 1 as amended.

3. Applicant is required to submit the drawing changes on replacement sheets as outlined below:

37 CFR 1.121 (d) requires that any drawing changes be submitted in compliance with 37 CFR 1.84 on replacement sheets as an attachment to an amendment

document. An accompanying detailed explanation of all of the changes should be provided on a separate sheet in the drawing amendments or remarks section of the amendment document. A marked-up copy of one or more of the figures being amended, with annotations, may also be included to provide further explanation of the changes made. The marked-up version must be labeled as "Annotated marked-up Drawings." Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per Sec. 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. No further drawing submission of the amended drawing figure(s) by applicant would be required, unless applicant is so notified.

Specification

4. The second substitute specification filed 11 AUG 2004 has not been entered because it does not comply with 37 CFR 1.125 as it lacks the statement that it includes no new matter and a marked-up version is lacking as mandated by Rule 125.

Appropriate correction is required.

5. The substitute Abstract of the Disclosure filed 11 AUG 2004 is objected to because:

a. the inclusion of legal phraseology such as "means" in the abstract is improper.

Correction is required. See MPEP § 608.01(b). No substitute abstract can be found in the responses filed subsequent to the first office action.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(l).

Correction of the following is required:

a. The subject matter of claim 3 (the recited chemical structure) lacks antecedent basis in the specification. Note the chemical structure of VITON added to page 9, line 20 of the substitute specification does not match the chemical structure recited in claim 3.

Claim Rejections - 35 U.S.C. § 112, first paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The limitation in amended claim 2 regarding the now claimed lip seals having a substantially squared cross section is not supported by the originally filed disclosure nor by Fig. 9 which is considered to best show this aspect of the invention. Claim 2 therefore involves new matter and should be cancelled. With regard to Applicant's remarks on this issue filed 11 AUG 2004, the lip seals are comprised of base sections which abut the element 68B and the depending lips 88B, 88C. Thus the base of the lip seal appears to actually have a rectangular cross section as seen in Fig. 9 rather than a square cross section (defined as four equal sides) but in any event, the overall shape of the lip seal (which is of course the base and lip) can hardly be considered to of "squared cross section" as recited in claim 2. Claim 2 therefore still contains new matter.

8. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 U.S.C. § 112, second paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1723

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4: thus claim has been cancelled so the rejection set forth in the final rejection is moot.

Claim 6, line 2: "the oil seal retainer" lacks antecedent basis.

Claim Amendments - 37 CFR 1.121

11. The claims were improperly amended pursuant to the Revised Amendment Practice to 37 CFR 1.121 and thus the amendment is non-responsive and wholly non-enterable for this reason alone. See <http://www.uspto.gov/web/patents/ifw/>.

Claim 1 shows "Currently amended" but indicates no amendments via strikethrough and/or underlining.

Claim 2 shows "Currently amended" but indicates no amendments via strikethrough and/or underlining.

Claim 3 contains the improper status identifier "Earlier amended". The proper status identifier is --Previously presented--. No deviations from the seven approved status identifiers are permitted.

Claim 4 shows the status identifier "Canceled". The text of canceled claims must not be presented.

Claim 5 shows the status identifier "Withdrawn". The subject matter of claim 5 was placed into claim 1. Claim 5 cannot be withdrawn but must be --Cancelled--.

Claim 6 shows "Currently amended" but indicates no amendments via strikethrough and/or underlining.

Claim 7 contains the improper status identifier "Earlier amended". The proper status identifier is --Previously presented--. No deviations from the seven approved status identifiers are permitted. Furthermore, the claim was amended by the removal of an extraneous "the" and must be depicted as such and identified as -- Currently amended--.

Claim 8 shows the status identifier "Canceled". The text of canceled claims must not be presented.

Art Unit: 1723

12. Accordingly, the entire response filed 11 AUG 2004 is non-responsive, cannot be entered, and thus fails to place the application in condition for allowance. Any further response requires extensive revision to comply with the objections and rejections set forth in the final rejection as well as the referenced patent rules outlined above.

A handwritten signature in cursive script, appearing to read "Charles", followed by a stylized, wavy line.

Charles E. Cooley
Primary Examiner
Art Unit 1723

20 AUG 2004